

1328  
U.S. PTO  
040804

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# UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No. 0942.285000O/BJD/JKM  
First Inventor James L. HARTLEY  
Title See 1 in Addendum  
Express Mail Label No.

22278 U.S. PTO  
10/820133

## APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

## ADDRESS TO:

Mail Stop Patent Application  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)  
(Submit an original and a duplicate for fee processing)
2. ☐ Applicant claims small entity status.  
See 37 CFR 1.27.
3. ☒ Specification [Total Pages 96]  
(preferred arrangement set forth below)
  - Descriptive title of the invention
  - Cross Reference to Related Applications
  - Statement Regarding Fed sponsored R & D
  - Reference to sequence listing, a table, or a computer program listing appendix
  - Background of the Invention
  - Brief Summary of the Invention
  - Brief Description of the Drawings (if filed)
  - Detailed Description
  - Claim(s)
  - Abstract of the Disclosure
4. ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets 58]
5. Oath or Declaration [Total Sheets 3]
  - a. ☐ Newly executed (original or copy)
  - b. ☒ Copy from a prior application (37 CFR 1.63(d))  
(for continuation/divisional with Box 18 completed)
    - i. ☐ **DELETION OF INVENTOR(S)**  
Signed statement attached deleting inventor(s) name in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).
6. ☒ Application Data Sheet. See 37 CFR 1.76

7. ☐ CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)
  - a. ☐ Computer Readable Form (CRF)
  - b. Specification Sequence Listing on:
    - i. ☐ CD-ROM or CD-R (2 copies); or
    - ii. ☒ Paper
  - c. ☒ Statements verifying identity of above copies

## ACCOMPANYING APPLICATION PARTS

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 CFR 3.73(b) Statement of Power of Attorney (when there is an assignee)
11. ☐ English Translation Document (if applicable)
12. ☐ Information Disclosure Statement (IDS)/PTO-1449
13. ☒ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503) (Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s) (if foreign priority is claimed)
16. ☐ Nonpublication Request under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent.
17. ☒ Other: See 2 in Addendum  
The name of the assignee is: Invitrogen Corporation

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in the first sentence of the specification following the title, or in an Application Data Sheet under 37 CFR 1.76:

☒ Continuation ☐ Divisional ☐ Continuation-in-part (CIP) of prior application No.: 09/177,387

Prior application information: Examiner Lambertson, D.A. Art Unit: 1636

For CONTINUATION OF DIVISIONAL APPS only; The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

## 19. CORRESPONDENCE ADDRESS

☒ Customer Number: 26111 OR ☐ Correspondence address below

Name			
Address			
City	State	Zip Code	
Country	Telephone	Fax	

Name (Print/Type)	Brian J. Del Buono	Registration No. (Attorney/Agent)	42,473
Signature		Date	April 8, 2004

This collection of information is required by 37 CFR 1.53(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

13281

PTO/SB/17 (10-03)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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U.S. PTO

# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT** (\$) 1,086.00

## Complete if Known

Application Number	To Be Assigned
Filing Date	Herewith
First Named Inventor	James L. HARTLEY
Examiner Name	To Be Assigned
Art Unit	To Be Assigned
Attorney Docket No.	0942.2850000/BJD/JKM

## METHOD OF PAYMENT (check all that apply)

☐ Check ☒ Credit card ☐ Money Order ☒ Other\*\* ☐ None

☐ \*\*Charge any deficiencies or credit any overpayments in Deposit Account: the fees to Deposit Acct. No. 19-0036

 Deposit Account Number  
 Deposit Account Name

19-0036

Sterne Kessler, Goldstein &amp; Fox P.L.L.C.

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments

☐ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	770.00
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
<b>SUBTOTAL (1)</b>					<b>(\$)</b> 770.00

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		Extra Claims		Fee from below		Fee Paid	
Independent Claims	28	- 20	**= 8	X 18.00	=	144.00	
Multiple Dependent	5	- 3	**= 2	X 86.00	=	172.00	

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

**SUBTOTAL (2)** (\$) 316.00

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

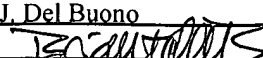
Other fee (specify) \_\_\_\_\_

\*Reduced by Basic Filing Fee Paid

**SUBTOTAL (3)** (\$) 0.00

## SUBMITTED BY

(Complete if applicable)

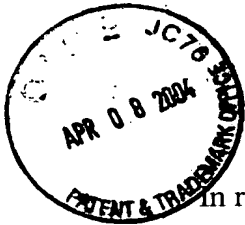
Name (Print/Type)	Brian J. Del Buono	Registration No. (Attorney/Agent)	42,473	Telephone	(202) 371-2600
Signature		Date	April 8, 2004		

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Addendum to Rule 53(b) Continuation of Appl. No. 09/177,387  
(Docket No. 0942.285000O/BJD/JKM)

1. Recombinational Cloning Using Nucleic Acids Having Recombination Sites
2. a. Authorization under 37CFR 1.136(a)(3); b. Request to Open New Disk File



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

HARTLEY *et al.*

Appl. No.: *To Be Assigned (Rule 53(b)*  
*Continuation of Appl. No. 09/177,387;*  
*Filed: October 23, 1998)*

Filed: *Herewith*

For: **Recombinational Cloning Using  
Nucleic Acids Having  
Recombination Sites**

Confirmation No.: *To Be Assigned*

Art Unit: *To Be Assigned*

Examiner: *To Be Assigned*

Atty. Docket: 0942.285000O/BJD/JKM

**Authorization to Treat a Reply as Incorporating an  
Extension of Time Under 37 C.F.R. § 1.136(a)(3)**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

The U.S. Patent and Trademark Office is hereby authorized to treat any concurrent or future reply that requires a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. The U.S. Patent and Trademark Office is hereby authorized to charge all required extension of time fees to our Deposit Account No. 19-0036, if such fees are not otherwise provided for in such reply.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Brian J. Del Buono  
Attorney for Applicants  
Registration No. 42,473

Date: April 8, 2004

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April 8, 2004

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Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**Mail Stop Patent Application**

Re: U.S. Non-Provisional Utility Patent Application under 37 C.F.R. § 1.53(b)  
Appl. No. *To Be Assigned*; Filed: *Herewith*  
(*Rule 53(b) Continuation of Appl. No. 09/177,387; Filed: October 23, 1998*)  
For: **Recombinational Cloning Using Nucleic Acids Having Recombination Sites**  
Inventors: HARTLEY *et al.*  
Our Ref: 0942.285000O/BJD/JKM

Sir:

The following documents are forwarded herewith for appropriate action by the U.S. Patent and Trademark Office:

1. PTO Fee Transmittal (Form PTO/SB/17);
2. PTO Utility Patent Application Transmittal (Form PTO/SB/05);
3. Authorization to Treat a Reply As Incorporating An Extension of Time Under 37 C.F.R. § 1.136(a)(3);
4. Form PTO-2038 Credit Card Payment Form in the amount of \$1,086.00 to cover:

\$770.00 Patent Application filing fee;  
\$144.00 Excess claims fee; and  
\$172.00 Excess independent claims fee;

5. U.S. Utility Patent Application entitled:

**Recombinational Cloning Using Nucleic Acids Having Recombination Sites**

and naming as inventors:

James L. HARTLEY, Michael A. BRASCH, Gary F. TEMPLE and Donna K. FOX

the application consisting of:

- a. An Application Data Sheet (37 C.F.R. § 1.76);
  - b. A copy of the executed Declaration by James L. HARTLEY and Michael A. BRASCH on October 21, 1998, Gary F. TEMPLE on October 22, 1998, and Donna K. FOX on October 23, 1998 (3 pages) as originally filed in 35 U.S.C. § 120 priority U.S. Appl. No. 09/177,387;
  - c. A specification containing:
    - i. 94 pages of description prior to the claims;
    - ii. 1 page of claims (1 claim); and
    - iii. a one (1) page abstract;
  - d. 19 pages of a paper copy of a sequence listing filed on October 23, 1998, in the 35 U.S.C. § 120 priority U.S. Appl. No. 09/177,387; and
  - e. 58 sheets of drawings: (Figures 1, 2A-2F, 3A-3F, 4A-4F, 5A-5H, 6A-6B, 7A-7D, 8A-8K, 9A-9C, 10A-10D, 11A-11C and 12A-12D);
6. Preliminary Amendment Under 37 C.F.R. § 1.115;
  7. Request to Open New Disk File; and
  8. Two (2) return postcards.

In accordance with 37 C.F.R. § 1.821(f), the paper copy of the sequence listing filed herewith and the computer readable copy of the sequence listing filed on April 15, 1999, in the 35 U.S.C. § 120 priority U.S. Appl. No. 09/177,387, filed October 23, 1998, are the same.

Commissioner for Patents  
April 8, 2004  
Page 3

It is respectfully requested that, of the two attached postcards, one be stamped with the filing date of these documents and returned to our courier, and the other, prepaid postcard, be stamped with the filing date and unofficial application number and returned as soon as possible.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "Brian J. Del Buono", with a stylized flourish at the end.

Brian J. Del Buono  
Attorney for Applicants  
Registration No. 42,473

BJD/JKM:bac

249456\_1.DOC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

HARTLEY *et al.*

Appl. No.: *To Be Assigned (Rule 53(b)*  
*Continuation of U.S. Appl. No.*  
*09/177,387; Filed: October 23, 1998)*

Filed: *Herewith*

For: **Recombinational Cloning Using  
Nucleic Acids Having  
Recombination Sites**

Confirmation No.: *To Be Assigned*

Art Unit: *To Be Assigned*

Examiner: *To Be Assigned*

Atty. Docket: 0942.285000O/BJD/JKM

**Request to Open New Disk File**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants request that a new disk file be opened for the above-cited application. The Sequence Listing disk submitted on **April 15, 1999** in the 35 U.S.C. § 120 priority U.S. Application No. **09/177,387**, filed **October 23, 1998**, contains the identical sequence information as that in the present application. Applicants also submit herewith a paper copy of the sequence listing for the present application. The paper copy of the sequence listing and the computer readable copy are the same and do not introduce new matter.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono  
Attorney for Applicants  
Registration No. 42,473

Date: April 8, 2004

1100 New York Avenue, N.W.  
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